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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/812,476	03/29/2004	Douglas C. Harrington	212/572	3267

23371 7590 10/10/2006

CROCKETT & CROCKETT  
24012 CALLE DE LA PLATA  
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LAGUNA HILLS, CA 92653

EXAMINER

ROLLINS, ROSILAND STACIE

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 10/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/812,476

Applicant(s)

HARRINGTON ET AL.

Examiner

Rosiland S. Rollins

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 3/29/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 3/29/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

The use of the trademark TEFLON has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 19, 20, 37 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Montaldi (US 47007014). Montaldi discloses a method of occluding the ovarian pathway of a female body, the method comprising the steps of: applying a heating element to a target segment of the pathway, and operating the heating element to heat the target segment in the pathway; installing a plug into the target segment of the pathway. Montaldi teaches all of the limitations of the claims except limiting the heating of the target segment by applying power of 0.1 to 5 watts to the heating element for a period of at least about 5 seconds. To have provided the power within the range claimed would have been obvious to one of ordinary skill in the art at the time the invention was made since it has been held that discovering the optimal workable range involves only routine skill.

Claims 3-8, 21-26 and 39-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Montaldi in view of Schaer (US 6595989). Montaldi teach all of the limitations of the claims except, providing the heating element in the form of at least one electrode adapted for application to the ovarian pathway; applying RF energy to the target segment through the electrode; providing the heating element in the form of at least two electrodes adapted for application to the ovarian pathway, and applying bi-polar RF energy to the electrodes; providing the heating element in the form of at least one resistive heating element adapted for application to the ovarian pathway; providing the heating element in the form of at least one microwave heating element adapted for application to the ovarian pathway; providing the heating element in the form of at least one ultrasound heating element adapted for application to the ovarian pathway and providing the heating element in the form of at least one laser heating element adapted for application to the ovarian pathway. Schaer teach that it is old and well known in the art to provide the heating element in the form of at least one electrode adapted for application to the ovarian pathway; applying RF energy to the target segment through the electrode; provide the heating element in the form of at least two electrodes adapted for application to the ovarian pathway, and applying bi-polar RF energy to the electrodes; provide the heating element in the form of at least one resistive heating element adapted for application to the ovarian pathway; provide the heating element in the form of at least one microwave heating element adapted for application to the ovarian pathway; provide the heating element in the form of at least one ultrasound heating element adapted for application to the ovarian pathway and provide the heating

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element in the form of at least one laser heating element adapted for application to the ovarian pathway. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the various sources of energy with the Montaldi device, particularly in view of the teaching of Schaer.


Claims 9-18, 27-36 and 46-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Montaldi. Montaldi teaches all of the limitations of the claims except providing the plug in the form of a reticulated foam plug having pores with pore sizes in the range of 40 to 200 microns; providing the plug in the form of a reticulated foam plug having pores with pore sizes in the range of 1 to 20 microns; providing the foam plug in the form of silicone foam having a durometer value of 20-100 Shore A ;providing the foam plug in the form of silicone foam having a durometer value of about 60 Shore A; providing the foam plug in the form of an ePTFE plug; providing the foam plug in the form of an acrylic copolymer plug; providing the foam plug in the form of silicone foam having a durometer value of 20-100 Shore A; providing the foam plug in the form of silicone foam having a durometer value of about 60 Shore A; providing the foam plug in the form of an ePTFE plug; providing the foam plug in the form of an acrylic copolymer plug. To have provided a plug constructed of the material as claimed would have been obvious to one of ordinary skill in the art at the time the invention was made since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rosiland S. Rollins whose telephone number is (571) 272-4772. The examiner can normally be reached on Mon.-Fri. 9:00 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Rosiland S. Rollins  
Primary Examiner  
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